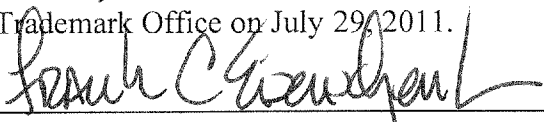


I hereby certify that this correspondence is being electronically filed in the United States Patent and Trademark Office on July 29, 2011.



Frank C. Eisenschenk, Ph.D., Patent Attorney

RESPONSE TO DECISION
Docket No. TPI.5053C3XC1T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 1626
Applicants : Magali Bourghol Hickey, Matthew Peterson, Örn Almarsson, Michael J. Zaworotko, Tanise Shattock, Jennifer McMahon, Joanna Bis, Julius F. Remenar, Mark Tawa
Serial No. : 10/599,010
Filed : September 18, 2006
Conf. No. : 3133
For : Novel Pharmaceutical Forms, and Methods of Making and Using the Same

Mail Stop PETITION
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO DECISION

Sir:

A Decision was received from the Patent and Trademark Office on July 5, 2011 in the above-referenced patent application indicating that the Notification of Acceptance mailed August 1, 2007 was vacated because the Declaration did not comply with 37 CFR 1.497(a)-(b). Transmitted herewith is a fully executed Declaration (37 CFR § 1.63) for Utility or Design Application Using an Application Data Sheet form for the subject application executed by all the inventors, along with a Supplemental Application Data Sheet.

The Decision also indicates that the Petition Under 37 C.F.R. 1.48(b) filed on November 9, 2007 has not been acted on at this time. By way of this response, Applicants respectfully request consideration of the Petition in due course.

The Commissioner is authorized to charge any fees that may be required by this paper to Deposit Account No. 19-0065.

Respectfully submitted,



Frank C. Eisenschenk, Ph.D.

Patent Attorney

Registration No. 45,332

Phone No.: 352-375-8100

Fax No.: 352-372-5800

Address: P.O. Box 142950
Gainesville, FL 32614-2950

FCE/jb/sl

Attachments: Executed Declaration
Supplemental ADS

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76)**

Title of
Invention

Novel Pharmaceutical Forms, and Methods of Making and Using the Same

As the below named inventor(s), I/we declare that:

This declaration is directed to:

- ☐ The attached application, or
☒ Application No. PCT/US2005/009305, filed on MARCH 17, 2005,
☒ as amended on 9/18/2006; 7/23/2008 (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

All statements made herein of my/own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME OF INVENTOR(S)

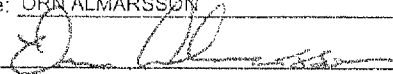
Inventor one: MAGALI BOURGHOL HICKEY

Signature:  Citizen of: UNITED STATES

Inventor two: MATTHEW PETERSON

Signature: _____ Citizen of: UNITED STATES

Inventor three: ORN ALMARSSON

Signature:  Citizen of: ICELAND

Inventor four: MICHAEL J. ZAWOROTKO

Signature: _____ Citizen of: UNITED KINGDOM

☒ Additional inventors or a legal representative are being named on 1 (one) additional form(s) attached hereto.

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 minute to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76) – continuation page

Title of Invention: Novel Pharmaceutical Forms, and Methods of Making and Using the Same
Application No.: PCT/US2005/009305, filed on March 17, 2005
as amended on 09/18/2006; 07/23/2008

Inventor five: TANISE SHATTOCK

Signature: _____ Citizen of: JAMAICA

Inventor six: JENNIFER McMAHON

Signature: _____ Citizen of: UNITED STATES

Inventor seven: JOANNA BIS

Signature: _____ Citizen of: POLAND

Inventor eight: JULIUS REMENAR


Signature:  _____ Citizen of: UNITED STATES

Inventor nine: MARK TAWA

Signature:  _____ Citizen of: UNITED STATES

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76)**

Title of Invention	Novel Pharmaceutical Forms, and Methods of Making and Using the Same
<p>As the below named inventor(s), I/we declare that:</p> <p>This declaration is directed to:</p> <p><input type="checkbox"/> The attached application, or</p> <p><input checked="" type="checkbox"/> Application No. <u>PCT/US2005/009305</u>, filed on <u>MARCH 17, 2005</u></p> <p><input checked="" type="checkbox"/> as amended on <u>9/18/2006; 7/23/2008</u> (if applicable);</p> <p>I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;</p> <p>I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above.</p> <p>I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.</p> <p>All statements made herein of my/own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.</p>	

FULL NAME OF INVENTOR(S)	
Inventor one: <u>MAGALI BOURGHOL HICKEY</u>	
Signature: _____	Citizen of: <u>UNITED STATES</u>
Inventor two: <u>MATTHEW PETERSON</u>	
Signature: <u></u>	Citizen of: <u>UNITED STATES</u>
Inventor three: <u>ORN ALMARSSON</u>	
Signature: _____	Citizen of: <u>ICELAND</u>
Inventor four: <u>MICHAEL J. ZAWOROTKO</u>	
Signature: _____	Citizen of: <u>UNITED KINGDOM</u>
<input checked="" type="checkbox"/> Additional inventors or a legal representative are being named on <u>1 (one)</u> additional form(s) attached hereto.	

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If you need assistance in completing the form, call 1-800-PTO-0199 and select option 2

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76) – continuation page

Title of Invention: Novel Pharmaceutical Forms, and Methods of Making and Using the Same
Application No.: PCT/US2005/009305, filed on March 17, 2005
as amended on 09/18/2006; 07/23/2008

Inventor five: TANISE SHATTOCK

Signature: _____ Citizen of: JAMAICA

Inventor six: JENNIFER McMAHON

Signature: _____ Citizen of: UNITED STATES

Inventor seven: JOANNA BIS

Signature: _____ Citizen of: POLAND

Inventor eight: JULIUS REMENAR

Signature: _____ Citizen of: UNITED STATES

Inventor nine: MARK TAWA

Signature: _____ Citizen of: UNITED STATES

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76)**Title of
Invention

Novel Pharmaceutical Forms, and Methods of Making and Using the Same

As the below named inventor(s), I/we declare that

This declaration is directed to:

☐

The attached application, or

☒Application No. PCT/US2005/009305, filed on MARCH 17, 2005☒as amended on 9/18/2006; 7/23/2008 (if applicable).

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.55, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

All statements made herein of my/own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME OF INVENTOR(S)

Inventor one: MAGALI BOURGHOL HICKEY

Signature: _____

Citizen of: UNITED STATESInventor two: MATTHEW PETERSON

Signature: _____

Citizen of: UNITED STATESInventor three: ORN ALMARSSON

Signature: _____

Citizen of: ICELANDInventor four: MICHAEL J. ZAWOROTKOSignature: Citizen of: UNITED KINGDOM☒Additional inventors or a legal representative are being named on 1 (one) additional form(s) attached hereto.

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DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76) – continuation page

Title of Invention: Novel Pharmaceutical Forms, and Methods of Making and Using the Same
Application No.: PCT/US2005/009305, filed on March 17, 2005
as amended on 09/18/2006; 07/23/2008

Inventor five: TANISE SHATTOCK

Signature: _____ Citizen of: JAMAICA

Inventor six: JENNIFER McMAHON

Signature: _____ Citizen of: UNITED STATES

Inventor seven: JOANNA BIS

Signature: _____ Citizen of: POLAND

Inventor eight: JULIUS REMENAR

Signature: _____ Citizen of: UNITED STATES

Inventor nine: MARK TAWA

Signature: _____ Citizen of: UNITED STATES

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**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76)**

Title of Invention	Novel Pharmaceutical Forms, and Methods of Making and Using the Same
-------------------------------	---

As the below named inventor(s), I/we declare that:

This declaration is directed to:

☐ The attached application, or

☒ Application No. PCT/US2005/009305, filed on MARCH 17, 2005

☒ as amended on 9/18/2006; 7/23/2005 (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

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All statements made herein of my/own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME OF INVENTOR(S)	
Inventor one: <u>MAGALI BOURGHOL HICKEY</u>	
Signature: _____	Citizen of: <u>UNITED STATES</u>
Inventor two: <u>MATTHEW PETERSON</u>	
Signature: _____	Citizen of: <u>UNITED STATES</u>
Inventor three: <u>ORN ALMARSSON</u>	
Signature: _____	Citizen of: <u>ICELAND</u>
Inventor four: <u>MICHAEL J. ZAWOROTKO</u>	
Signature: _____	Citizen of: <u>UNITED KINGDOM</u>

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APPLICATION DATA SHEET (37 CFR 1.76) – continuation page

Title of Invention: Novel Pharmaceutical Forms, and Methods of Making and Using the Same
Application No.: PCT/US2005/009305, filed on March 17, 2005
as amended on 09/18/2006; 07/23/2008

Inventor five: TANISE SHATTOCK

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Signature: _____ Citizen of: UNITED STATES

Inventor nine: MARK TAWA

Signature: _____ Citizen of: UNITED STATES

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76)

Title of Invention	Novel Pharmaceutical Forms, and Methods of Making and Using the Same
<p>As the below named inventor(s), I/we declare that:</p> <p>This declaration is directed to:</p> <p style="margin-left: 40px;"><input type="checkbox"/> The attached application, or</p> <p style="margin-left: 40px;"><input checked="" type="checkbox"/> Application No. <u>PCT/US2005/009305</u>, filed on <u>MARCH 17, 2005</u></p> <p style="margin-left: 40px;"><input checked="" type="checkbox"/> as amended on <u>01/18/2006; 7/23/2008</u> (if applicable):</p> <p>I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought:</p> <p>I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above.</p> <p>I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.</p> <p>All statements made herein of my/own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.</p>	

FULL NAME OF INVENTOR(S)

Inventor one: MAGALI BOURGHOL HICKEY

Signature: _____ Citizen of: UNITED STATES

Inventor two: MATTHEW PETERSON

Signature: _____ Citizen of: UNITED STATES

Inventor three: ORN ALMARSSON

Signature: _____ Citizen of: ICELAND

Inventor four: MICHAEL J. ZAWOROTKO

Signature: _____ Citizen of: UNITED KINGDOM

☒ Additional inventors or a legal representative are being named on 1 (one) additional form(s) attached hereto

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DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76) -- continuation page

Title of Invention: Novel Pharmaceutical Forms, and Methods of Making and Using the Same
Application No.: PCT/US2005/009305, filed on March 17, 2005
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Inventor five: TANISE SHATTOCK

Signature: _____ Citizen of: JAMAICA

Inventor six: JENNIFER McMAHON

Signature: Jennifer McMahon Citizen of: UNITED STATES

Inventor seven: JOANNA BIS

Signature: _____ Citizen of: POLAND

Inventor eight: JULIUS REMENAR

Signature: _____ Citizen of: UNITED STATES

Inventor nine: MARK TAWA

Signature: _____ Citizen of: UNITED STATES

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76)

**Title of
Invention**

Novel Pharmaceutical Forms, and Methods of Making and Using the Same

As the below named inventor(s), I/we declare that:

This declaration is directed to:

- ☐ The attached application, or
- ☒ Application No. PCT/US2005/009305, filed on MARCH 17, 2005,
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FULL NAME OF INVENTOR(S)

Inventor one: MAGALI BOURGHOL HICKEY

Signature: _____ Citizen of: UNITED STATES

Inventor two: MATTHEW PETERSON

Signature: _____ Citizen of: UNITED STATES

Inventor three: ORN ALMARSSON

Signature: _____ Citizen of: ICELAND

Inventor four: MICHAEL J. ZAWOROTKO

Signature: _____ Citizen of: UNITED KINGDOM

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DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76) – continuation page

Title of Invention: Novel Pharmaceutical Forms, and Methods of Making and Using the Same
Application No.: PCT/US2005/009305, filed on March 17, 2005
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Inventor five: TANISE SHATTOCK

Signature: _____ Citizen of: JAMAICA

Inventor six: JENNIFER McMAHON

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Inventor seven: JOANNA BIS

Signature: Joanna Bis _____ Citizen of: POLAND

Inventor eight: JULIUS REMENAR

Signature: _____ Citizen of: UNITED STATES

Inventor nine: MARK TAWA

Signature: _____ Citizen of: UNITED STATES

PTO/SB/81 (04-05)

Approved for use through 11/30/2005. OMB 0851-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

POWER OF ATTORNEY and CORRESPONDENCE ADDRESS INDICATION FORM

Application Number	10/599,010
Filing Date	September 18, 2006
First Named Inventor	Magali Bourghol Hickey
Title	Novel Pharmaceutical Forms, ...
Art Unit	
Examiner Name	
Attorney Docket Number	TPI-5053C3XC1T

I hereby revoke all previous powers of attorney given in the above-identified application.

I hereby appoint:

☒ Practitioners associated with the Customer Number:

23557

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Please recognize or change the correspondence address for the above-identified application to:

☒ The address associated with the above-mentioned Customer Number:

OR

☐ The address associated with Customer Number:

OR

☐ Firm or Individual Name

Address

City

State

Zip

Country

Telephone

Email

I am the:

☒ Applicant/Inventor.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

SIGNATURE of Applicant or Assignee of Record

Signature		Date	Feb -23-2009
Name	JOANNA BIS	Telephone	
Title and Company			

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/81 (04-05)

Approved for use through 11/30/2005, OMB 0651-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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POWER OF ATTORNEY and CORRESPONDENCE ADDRESS INDICATION FORM

Application Number	10/599,010
Filing Date	September 18, 2006
First Named Inventor	Megali Bourghol Hickey
Title	Novel Pharmaceutical Forms, ...
Art Unit	
Examiner Name	
Attorney Docket Number	TPI-5053C3XC1T

I hereby revoke all previous powers of attorney given in the above-identified application.

I hereby appoint:

☒ Practitioners associated with the Customer Number:

23557

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

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☒ The address associated with the above-mentioned Customer Number.

OR

☐ The address associated with Customer Number:

OR

☐ Firm or
Individual Name

Address

City

State

Zip

Country

Telephone

Email

I am the:

☒ Applicant/Inventor.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

SIGNATURE of Applicant or Assignee of Record

Signature	<i>Jennifer McMahon</i>	Date	11-6-2008
Name	JENNIFER MCMAHON	Telephone	317-276-1543
Title and Company	Eli Lilly & Company		

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application Information

Application No.::	10/599,010
Filing date::	09/18/06
Application Type::	Regular (National Stage)
Subject Matter::	Utility
Suggested Classification::	None
Suggested Group Art Unit::	None
CD-ROM or CD-R?::	None
Number of CD disks::	None
Number of copies of CDs::	None
Sequence submission?::	None
Computer Readable Form?::	No
Number of Copies of CRF::	None
Title::	NOVEL PHARMACEUTICAL FORMS, AND METHODS OF MAKING AND USING THE SAME
Attorney Docket Number::	TPI-5053C3XC1T
Request for Early Publication::	No
Request for Non-Publication::	No
Suggested Drawing Figure::	None
Total Drawing Sheets::	17
Small Entity?::	No
Petition included?::	No
Petition Type::	N/A
Secrecy Order in Parent Appl.?::	No

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	US
Status::	Unknown
Inventor One Given Name::	Magali Bourghol
Family Name::	Hickey
City of Residence::	Medford
State or Province of Residence::	MA
Country of Residence::	US
Street of Mailing Address::	342 Malden Street
City of Mailing Address::	Medford
State or Province of mailing address::	MA
Country of Mailing Address::	US
Postal or Zip Code of Mailing Address::	02155

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	US
Status::	Unknown
Inventor Two Given Name::	Matthew L.
Family Name::	Peterson
City of Residence::	Hopkinton
State or Province of Residence::	MA
Country of Residence::	US
Street of Mailing Address::	25 Downey Street
City of Mailing Address::	Hopkinton
State or Province of mailing address::	MA
Country of Mailing Address::	US
Postal or Zip Code of Mailing Address::	01748

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	IS
Status::	Unknown
Inventor Three Given Name::	Örn
Family Name::	Almarsson
City of Residence::	Shrewsbury
State or Province of Residence::	MA
Country of Residence::	US
Street of Mailing Address::	22 Farmington Drive
City of Mailing Address::	Shrewsbury
State or Province of mailing address::	MA
Country of Mailing Address::	US
Postal or Zip Code of Mailing Address::	01545

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	UK
Status::	Unknown
Inventor Four Given Name::	Michael J.
Family Name::	Zaworotko
City of Residence::	Tampa
State or Province of Residence::	FL
Country of Residence::	US
Street of Mailing Address::	19133 Dove Creek Drive
City of Mailing Address::	Tampa
State or Province of mailing address::	FL
Country of Mailing Address::	US
Postal or Zip Code of Mailing Address::	33647

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	JM
Status::	Unknown
Inventor Five Given Name::	Tanise
Family Name::	Shattock
City of Residence::	Orlando <u>Montville</u>
State or Province of Residence::	FL <u>NJ</u>
Country of Residence::	US
Street of Mailing Address::	3707 S. Lake Orlando Pkwy, Apt 7 <u>23 Highland Avenue</u>
City of Mailing Address::	Orlando <u>Montville</u>
State or Province of mailing address::	FL <u>NJ</u>
Country of Mailing Address::	US
Postal or Zip Code of Mailing Address::	32808 <u>07045</u>

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	US
Status::	Unknown
Inventor Six Given Name::	Jennifer
Family Name::	McMahon
City of Residence::	Tampa <u>Zionsville</u>
State or Province of Residence::	FL <u>IN</u>
Country of Residence::	US
Street of Mailing Address::	8801 Hunters Lake Drive, Apt. 233 <u>6568 Bainbridge Circle</u>
City of Mailing Address::	Tampa <u>Zionsville</u>
State or Province of mailing address::	FL <u>IN</u>
Country of Mailing Address::	US
Postal or Zip Code of Mailing Address::	33647 <u>46077</u>

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	PL
Status::	Unknown
Inventor Seven Given Name::	Joanna
Family Name::	Bis
City of Residence::	FL Cary
State or Province of Residence::	Tampa NC
Country of Residence::	US
Street of Mailing Address::	44414 Reuter Strasse, Apt. 1 <u>130 Trafalgar Ln</u>
City of Mailing Address::	FL Cary
State or Province of mailing address::	Tampa NC
Country of Mailing Address::	US
Postal or Zip Code of Mailing Address::	33613

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	US
Status::	Unknown
Inventor Eight Given Name::	Julius F.
Family Name::	Remenar
City of Residence::	Framingham
State or Province of Residence::	MA
Country of Residence::	US
Street of Mailing Address::	9 Eaton Road
City of Mailing Address::	Framingham
State or Province of mailing address::	MA
Country of Mailing Address::	US
Postal or Zip Code of Mailing Address::	01701

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	US
Status::	Unknown
Inventor Nine Given Name::	Mark
Family Name::	Tawa
City of Residence::	Acton
State or Province of Residence::	MA
Country of Residence::	US
Street of Mailing Address::	45 Flint Road
City of Mailing Address::	Acton
State or Province of mailing address::	MA
Country of Mailing Address::	US
Postal or Zip Code of Mailing Address::	01720

Representative Information

Representative Customer Number::	000023557
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Correspondence Information

Correspondence Customer Number::	000023557
Telephone Number One::	(352) 375-8100
Telephone Number Two::	
Fax Number::	(352) 372-5800
Electronic Mail Address::	fce@slspatents.com <u>fce@slpatents.com</u>

Domestic Priority Information

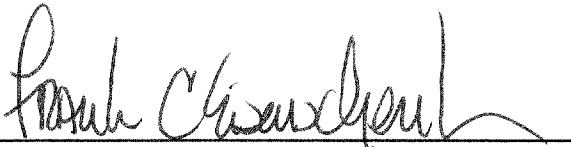
Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This application is a	National Stage of	PCT/US2005/009305	March 17, 2005
PCT/US2005/009305	An application claiming the benefit under 35 USC 119(e) of	60/554,834	March 19, 2004
And		60/566,647	April 30, 2004
And		60/610,296	September 16, 2004
And		60/637,907	December 21, 2004

Assignee Information

Assignee Name::	TransForm Pharmaceuticals, Inc.
Street of Mailing Address::	29 Hartwell Avenue
City of Mailing Address::	Lexington
Country of Mailing Address::	MA
Postal or Zip Code of Mailing Address::	02421

Assignee Information

Assignee Name::	University of South Florida
Street of Mailing Address::	3802 Spectrum Blvd., Suite 100
City of Mailing Address::	Tampa
Country of Mailing Address::	FL
Postal or Zip Code of Mailing Address::	33612-9220



Frank C. Eisenschenk, Ph.D.
Reg. No. 45,332
July 29, 2011